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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/852,184	05/09/2001	Glenn Petkovsek	USA-P-00-001	4886

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EXAMINER

HENDERSON, MARK T

ART UNIT

PAPER NUMBER

3722

DATE MAILED: 11/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/852,184	Applicant(s) PETKOVSEK, GLENN	
	Examiner Mark T Henderson	Art Unit 3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3722

DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9302 (Official) and (703)872-9303 (for After Finals). This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claim 1 has been amended for further examination.

Art Unit: 3722

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-7 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 18, 24 and 25 of U.S. Patent No. 6,089,613 (Petkovsek) in view of PAP US 2002/0103697 (Lockhart et al).

Petkovsek discloses in Claim 18, 24 and 25, a form having: a first layer made up of a plurality of parts with a front side and a backside, wherein the front side receives indicia, and the

Art Unit: 3722

backside comprises removable adhesive; and a second layer having a front side with a non-adhesive layer; wherein one of the plurality of parts receives information relating to the shipment and handling of the article, and is removable from the front side of the first layer and attaches to the mailpiece; and a post card section.

However, Petkovsek does not disclose; wherein a first part of the plurality of parts receives an electronically imaged postage information accessed over a global computer network necessary to effect delivery of the mailpiece; and a second part receives a second type of electronically imaged postage accessed over a global computer network necessary to effect delivery of the mailpiece; wherein the first part is sized to correspond to a first type of electronically-imaged postage; and wherein the second part is sized to correspond to a second type of electronically-imaged postage.

Lockhart discloses in Fig. 8, a form comprising a electronically imaged postage accessed over a global network.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Petkovsek's form to include electronically imaged indicia as taught by Lockhart et al for the purpose of allowing a user to cost-effectively create and distribute individualized surface mailings using an easy to use computer interface available over the Internet.

In regards to **Claim 1**, wherein the first and second part are sized to correspond to a first and second type of electronically imaged postage; and wherein the electronically image information is necessary to effect the delivery of the mailpiece, and is accessible by a first and

Art Unit: 3722

second provider; and wherein one of the first or second parts are attached to the mailpiece to effect the delivery of the mailpiece by the special services, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. Therefore, the first and second part is capable of being sized to correspond to electronically imaged postage, since applicant has not set forth the dimensional parameters of the electronically imaged postage; and further wherein the electronically imaged information is capable of effecting the delivery of the mailpiece. Furthermore, the electronically imaged postage can be accessible by a first and second provider.

Response to Arguments

3. Applicant's arguments filed on March 18, 2004 have been fully considered but they are not persuasive.

In regards to applicant's arguments that neither the Petkovsek or Lockhart et al taken singly or in combination, "teach or suggest a form for delivery of a mailpiece by a special service having a first part which is sized to correspond to a first type of electronically-imaged postage

Art Unit: 3722

accessed over a global computer network and having a second part which is sized to correspond to a second type of electronically-imaged postage accessed over a global computer network”, the examiner submits that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In this case, Petkovsek discloses a form having: a first layer made up of a plurality of parts with a front side and a backside, wherein the front side receives imaged indicia, and the backside comprises removable adhesive; and a second layer having a front side with a non-adhesive layer; wherein one of the plurality of parts receives special service mail information, sender information, and recipient information; a post card section. However, Petkovsek does not disclose; wherein a first part of the plurality of parts receives an electronically imaged postage accessed over a global computer network necessary to effect delivery of the mailpiece; and a second part receives a second type of electronically imaged postage accessed over a global computer network necessary to effect delivery of the mailpiece; wherein the first part is sized to correspond to a first type of electronically-imaged postage; and wherein the second part is sized to correspond to a second type of electronically-imaged postage.

Lockhart discloses in Fig. 8, a form comprising a electronically imaged postage (1110) accessed over a global network; wherein the image can be sized and the form can printed (Page 8, Par. 110 and 112).

Art Unit: 3722

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Petkovsek's form to include electronically imaged indicia as taught by Lockhart et al for the purpose of allowing a user to cost-effectively create and distribute individualized surface mailings using an easy to use computer interface available over the Internet.

In regards to **Claim 1**, wherein the first and second part are sized to correspond to a first and second type of electronically imaged postage; and wherein the electronically image information is necessary to effect the delivery of the mailpiece, and is accessible by a first and second provider, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Therefore, the first and second part is sized to correspond to electronically imaged postage, since applicant has not set forth the dimensional parameters of the electronically imaged postage; and further wherein the electronically imaged information is capable of effecting the delivery of the mailpiece. Furthermore, the electronically imaged postage can be accessible by a first and second provider.

Art Unit: 3722


Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

November 23, 2004



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